



APPELLANT'S REPLY BRIEF
U.S. Application No. 09/613,387

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of Atty. Docket No.: 2639-001
Mark E. VALENTI
Appln. No.: 09/613,387 Group Art Unit: 2155
Filing Date: July 11, 2000 Examiner: Tran, Philip B.

For: **SYSTEM AND METHOD FOR INTERNET BROADCAST SEARCHING**

REPLY BRIEF

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Dear Sir:

Applicant hereby submits this Reply Brief in response to the Examiner's Answer of
March 24, 2004.

Respectfully submitted,

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May 24, 2004

Atty. Dkt. No. 2639-001

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

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Dear Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b)(1), Appellant requests withdrawal of the final rejection and submits the following:

Appellant hereby affirms that items I-VII of, and the Appendix to, the Brief on Appeal filed January 5, 2004 remain the same. It is Appellant's understanding that there is no need to reiterate contentions and information which were set forth in the Brief on Appeal. See 62 Fed. Reg. 53,132, 53,169 (1997) ("Contentions (or information) set forth in a previously filed appeal (or reply brief) need not be reiterated in a reply brief or supplemental appeal brief.").

VIII. ARGUMENTS

The Examiner's Answer included a section titled *(11) Response to Argument* that addressed Issues 1-4. In reply, Appellant submits the following:

Issue 1

In the response to Issue 1, dealing with Appellant's assertion that there is no reason to combine Frauenhofer et al. with Hirai et al., the Examiner first makes numerous erroneous assertions.

The Examiner erroneously asserts "Frauenhofer teaches a method of *instantaneously searching* a network of interconnected computers and servers comprising a plurality of information servers connected to a network and *categorizing general content stored on themselves* and collecting and storing the categorization on at least one *IBSP server*" (emphasis added). However, to support this assertion, the Examiner states "Frauenhofer teaches collecting, categorizing and searching metadata about contents provided on the Internet and/or Intranet [see Figs. 1-2 and Abstract and Col. 2, Line 40 to Col. 3, Line 11 and Col. 4, Line 3 to Col. 5, Line 12]..."

The Abstract of Frauenhofer et al. clearly states:

A system for collecting, categorizing and searching metadata about content provided on the internet and/or intranet for delivery in accordance with customized user profiles. The *system collects internet information and categorizes same* for provision at a customer's intranet server. The *system* is additionally adapted to either *passively receive or actively collect* and *categorize internally-provided content* for delivery with the externally *gathered and categorized content* and for matching to user profiles. (Emphasis added).

Column 2, lines 48-50 of Frauenhofer et al. state:

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“The *System Server, 10*, gathers electronic content from content providers, as well as directly from sources, if necessary. *At the System Server, the electronic content is categorized...*” (Emphasis added).

As illustrated by the Abstract and Specification of Frauenhofer et al., the system server of Frauenhofer et al. *collects content and performs the categorization* of it. As such, it is clearly erroneous for the Examiner to assert that the plurality of information servers (sources 11, content providers, 12 and internal sources 15) categorize general content stored on themselves. Furthermore, it is clearly erroneous to assert that Frauenhofer et al. does instantaneous searching since, even when actively collecting content, it is physically impossible to have the most recent content at any instant due to the time necessary to accomplish the active collection.

The presently claimed invention involves no central collection or gathering of content and relies on the *information servers* to both categorize *general content* (whereas the system server of Frauenhofer et al. categorizes *specific content* into general categories) and perform self-searching at the instant of the query (e.g., “a plurality of information servers connected to a network and *categorizing general content stored on themselves*” and “the information servers instantaneously searching themselves for specific content responsive to the user node query” in claim 1), whereas any searching in Frauenhofer et al. is done on *previously gathered contents* on the *system server*.

In regards to search paradigms, Frauenhofer et al. falls clearly into the prior art paradigm discussed in the Appellant's specification, such as at page 1, lines 16-17 (systems that “attempt to build an index of the world wide web by accumulating website information in a centralized

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database on a centralized computer system”) and at page 3, lines 10-15 (“Other systems ... rely upon obtaining information or META-information about data that is stored in a network and searching that information.”). As stated by Appellant at page 3, line 16, “All of these techniques also suffer from the issue of currency.”

Appellant defines Internet Broadcast Search Paradigm (IBSP) in the specification at page 5, lines 6-8: “The present invention comprises an Internet Broadcast Search Paradigm (IBSP) which causes a search for information on the world wide web to be distributed to all website computers.” Since the system server of Frauenhofer et al. does not contribute to distribute a search for information, it cannot be properly considered an “IBSP Server” under M.P.E.P. 2111, which requires that claim terms be given there broadest reasonable interpretation *consistent with the specification*.

The Examiner’s Answer then cites *Constant v. Advanced Micro Devices, Inc.* for the proposition that argued points at pages 16-17 of the Appeal Brief were not claim limitations. However, taking claims 1-2 as examples, each argued point has a basis in the claims:

Argued Point	Claim Limitation
Content remains at the source and is not aggregated	collecting and storing the <i>categorization and network addresses</i> of the information servers on at least one IBSP server; the <i>information servers</i> instantaneously <i>searching themselves</i> for specific content responsive to the user node query (claim 1)
Categorization is of information servers' general contents, not any specific content	a plurality of information servers connected to a network and <i>categorizing general content</i> stored on themselves (claim 1)

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Categorization is not centralized, but rather is distributed since information servers / web servers perform self categorization	<i>a plurality of information servers</i> connected to a network and <i>categorizing</i> general content stored on themselves (claim 1)
Categorization of queries is not centralized, but rather is distributed since client software/users perform categorization	the <i>user node</i> <i>categorizing each user node query</i> prior to transmitting the user node query (claim 2)
Searching is not centralized since each information server searches themselves for responsive content	the <i>information servers</i> instantaneously <i>searching themselves for specific content</i> responsive to the user node query (claim 1)
Searching is in "real-time" since it is performed by the sources of the content	the <i>information servers</i> instantaneously <i>searching themselves for specific content</i> responsive to the user node query (claim 1)
Responses are not filtered since they are sent to the user from the source of the content	each of the plurality of <i>information servers</i> <i>transmitting a response to the user node query to the user node</i> when responsive content is found (claim 1)

The Examiner's Answer also cites *In re Keller* and *In re Merck & Co.* for the proposition that one cannot show non-obviousness by attacking references individually. Appellant initially notes that the rejection in the present case relies upon Frauenhofer et al. for all of the teachings except for the collection and storage of IP (network) addresses, for which the rejection relies upon a combination with Hirai et al.

However, with respect to the Examiner's argument regarding "attacking references individually," Appellant submits that the references were properly addressed for what they teach. In the present case, *as a whole*, Frauenhofer et al. teaches away from the presently claimed invention through its teaching that content is best searched and delivered after being *collected and categorized at a central location*, such that to modify Frauenhofer et al. to eliminate these

features would destroy a primary purpose of the Frauenhofer et al. invention.

Additionally, since the content is centrally collected, either passively or via a crawler (see column 3, lines 25-30 of Frauenhofer et al.), and then categorized in Frauenhofer et al., there is absolutely *no need to collect any categorization information or network addresses from the information servers* and therefore one of ordinary skill in the art would have *no need to look to* the network management system of Hirai et al. Likewise, since Hirai et al., *as a whole*, has nothing to do with Internet searching, it fails to suggest any reason why it would be desirable to modify Frauenhofer et al.

Although the Examiner argues on page 22 (and elsewhere) of the Examiner's Answer that it would be obvious to modify Frauenhofer et al. with Hirai et al. "in order to efficiently group information into different subject matters for easy retrieval data associated with categorized network addresses of appropriate sources," this reasoning makes no sense. As mentioned above, Frauenhofer et al. has already collected the content at the system server and therefore has no need to record network location for retrieval purposes since the content is already stored on the system server.

Issue 2

Issue 2 relates to Appellant's assertion that all limitations are not shown in Frauenhofer et al. and Hirai et al. Ironically, the Examiner alleges that Appellant has merely listed all claims without any substantive argument, when in fact, pages 18-31 of the Brief on Appeal are an exhaustive treatment of all of the claim limitations that are not found in the prior art *along with a*

detailed explanation of why each subject limitation is not found in the prior art. As mentioned on page 24 of the Brief on Appeal, the Appellant requested an element-by-element analysis of how the prior art allegedly met the claim limitations, but has yet to receive any such analysis from the Examiner.

Furthermore, the Appellant notes the complete lack of logic in the Examiner's statement on page 28 of the Examiner's Answer that "Claims 14-17 are dependent on claim 13 and thus are not patentable for at least the reasons set forth above to [sic] claim 13." Although it is true that a dependant claim can be *allowable* for depending on an *allowable* independent claim, the inverse with respect to rejected independent claims is not true due to the "further limiting" nature of dependent claims. As such, the Examiner's statement is absurd and erroneous.

Issue 3

Issue 3 relates to the claim rejections depending on Frauenhofer et al. and Hirai et al. -- "and further in view of Baker et al." In the paragraph spanning pages 28-29 of the Examiner's Answer, the Examiner repeats the asserted reason to combine Frauenhofer et al. and Hirai et al. that was discredited above, and it is herein that the Frauenhofer et al. , Hirai et al., and Baker et al. combination fails.

Appellant will readily concede that it would have been obvious to one of skill in the art to add a firewall to any network-connected device for security purposes, and Appellant has never argued otherwise. However, as submitted previously, 1) there is no valid reason to combine Frauenhofer et al. and Hirai et al. and 2) all of the claim limitations except for a firewall are not

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found in the prior art of Frauenhofer et al. and Hirai et al. The addition of Baker et al. does nothing to remedy the deficiencies of Frauenhofer et al. and Hirai et al., such that the combination of Frauenhofer et al., Hirai et al., and Baker et al. fails to make a *prima facie* case of obviousness for the same reasons as the combination of Frauenhofer et al. and Hirai et al. fails to make a *prima facie* case of obviousness with respect to the earlier claims.

Furthermore, there would be no reason to implement the firewall of Baker et al. in the manner of claim 7 -- as "a plurality of firewall servers each comprising instructions for receiving the network addresses and the categorization of the information servers from the IBSP server" -- absent impermissible hindsight.

Issue 4

Issue 4 relates to Appellant's argument that the present invention does instantaneous searching of network content, whereas the prior art (Frauenhofer et al.) does not.

The Examiner first objects/disagrees with the Appellant's definitions of "real-time" as "instantaneous" and then provides his own definition of "instantaneous" without reference to any source. Since Appellant argued both terms by using the phrase " 'real time' (i.e., instantaneous)" and only the terms "instantaneous" and "instantaneously" appear in the specification and claims, the Examiner's first objection is immaterial.

However, the Examiner's unfounded definition of "instantaneous" as meaning "responsive" is both material and erroneous. Because the term "instantaneously" is a claim term, the Examiner must, in accordance with M.P.E.P. 2111, give the term its "broadest reasonable

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interpretation consistent with the specification.” In the present case, reasonable interpretations can be found in the dictionary. A quick perusal of various definitions yield none meaning “responsive.” The first two from the *The American Heritage® Dictionary of the English Language, Fourth Edition*, Copyright © 2000; the next two from *Webster's Revised Unabridged Dictionary*, © 1996, 1998:

1. Occurring or completed without perceptible delay: *Relief was instantaneous.*
2. Present or occurring at a specific instant: *instantaneous velocity; instantaneous pressure.*
3. Done or occurring in an instant, or without any perceptible duration of time; *as, the passage of electricity appears to be instantaneous.*
4. At or during a given instant; *as, instantaneous acceleration, velocity, etc.*

Furthermore, the term or its root “instantaneous” is discussed multiple times in the specification. At page 2, line 5, it is discussed in reference to the prior art: “Because of the structure of the centralized indexed database, search engines are relatively static and do not receive instantaneous updates of information on individual websites as those websites change.” Even if Frauenhofer et al. actively collects and categorizes content, it will remain a centralized indexed database, and thus is not considered instantaneous with respect to the present invention.

The term is further discussed with respect to the present invention at page 4, lines 15-16: “It is a further objective of the present invention to allow each search request to instantaneously account for changes in information at each website.” As such, in order to be instantaneous in a manner consistent with the specification, a search system must “allow each search request to ... account for changes in information at each website” with little or no delay. It is impossible for a centralized indexed database to account for the present state of each and every indexed piece of

content, but if the searching is done by the content provider, they can instantaneously account for any changes in their own content -- this is the Internet Broadcast Search Paradigm that Appellant submits is a major innovation provided by the present invention that is not taught or fairly suggest by the prior art.

IX. CONCLUSION

For the above reasons, Appellant respectfully submits that the Application conforms to the requirements of 35 U.S.C. §102/103 and that the Final Office Action of July 15, 2003 and Examiner's Answer of March 24, 2004 have failed to make out a *prima facie* case of obviousness with regard to claims 1-17, and therefore asks that the obviousness rejections be reversed.

The present Reply Brief is being filed in triplicate.

Appellant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 18-1579.

Respectfully submitted,



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